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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/813,950	03/03/97	ASSMUS	M 583-252-0-FW

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IM12/0727

EXAMINER

SELLERS, R

ART UNIT PAPER NUMBER

1712 23

DATE MAILED: 07/27/98

This is a communication from the examiner in charge of your application.
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OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on May 11, 1998
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1, 3, 5, 7, 9, 11, 13, 15 and 17-24 is/are pending in the application.
- Of the above, claim(s) 1, 3, 5, 7, 9, 11, 13 and 15 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 17-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING PAGES

Serial Number: 08/813,950

Page 2

Art Unit: 1712

The request filed on May 11, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/813,950 is acceptable and a CPA has been established. An action on the CPA follows.

This application contains claims 1, 3, 5, 7, 11, 13 and 15 drawn to an invention nonelected with traverse in Paper No. 12. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 204,596.

Canadian Patent No. 2,082,573 is withdrawn in response to the claimed composition wherein the thermoplastic coating and binding agent consists of a thermoplastic acrylic plastic and a flow improver which precludes the hydroxyalkylcellulose of the reference.

Otherwise, the rejection is maintained for the reasons of record set forth in the previous Office action. The arguments filed May 11, 1998 (Paper No. 22) have been considered but are unpersuasive.

Art Unit: 1712

The European patent (page 11, Table II, Example 17) shows a binding agent composed exclusively of an Eudragit thermoplastic acrylic resin (page 3, lines 10-11) and Precirol glycerol palmito-stearate (col. 4, lines 24-25) which conforms to the claimed binding agent consisting of a thermoplastic acrylic plastic and a flow improver.

The supplemental response filed March 20, 1998 (Paper No. 18) on pages 4-5 attempts to distinguish the claimed binding agent consisting of a non-homogeneous mixture of the thermoplastic acrylic and flow improver over the alleged two lipid excipients of the European patent which supposedly yields a homogeneous granulate. Page 4, lines 16-18 indicates that the solubilizing or gelling capacity and lubricating effect can be contributed by a single lipid excipient such as a fatty acid mono-, di- or triglyceride as confirmed by the term "lipid excipient(s)" and substantiated by Example 17.

The specification describes the non-homogeneity of the mixture as arising from the solidification of the mixture from the melt wherein the mixture prior to solidification is homogeneous (page 7, lines 5-22 and page 11, lines 13-17). The claims encompass the blend of the European patent which would inherently exhibit the claimed non-homogeneity upon solidification based on the equivalent types and amounts of thermoplastic acrylic and fatty acid mono-, di- or triglyceride. The claimed non-homogeneous mixture is qualified in the specification as only apparent after solidification and therefore embraces the prior art combination wherein the fatty acid mono-, di- or triglyceride solubilizes the polymer.

Art Unit: 1712


All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Robert Sellers at telephone number (703) 308-2399 (Fax no. (703) 305-3599).

rs

7/24/98


ROBERT E. SELLERS
PRIMARY EXAMINER
GROUP 150